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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Nobuo Oyama

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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

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12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,356	<b>Applicant(s)</b> OYAMA, NOBUO	
	<b>Examiner</b> DANIEL L. GREENE	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/6/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-6 were pending. In the response received 9/19/2008, Applicant elected Species b (from the previous requirement for restriction mailed 8/21/2008) and cancelled claims 4 and 6. Accordingly a first action on the merits of claims 1-3 and 5 follows.

### ***Election/Restrictions***

2. Applicant's election without traverse of Species b in the reply filed on 9/19/2008 is acknowledged.

### ***Priority***

3. The foreign priority claim filed on 7/6/2005 was not entered because the foreign priority claim was not filed during the time period set forth in 37 CFR 1.55(a)(1). For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f) or 365(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim (37 CFR 1.55(c)). The petition must be accompanied by (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d)

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and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

4. Per the Office communication mailed 3/29/2006, applicant has been accorded the filing date of 3/6/2006 **NOT** 7/6/2005. Accordingly, applicants request for priority fails to comply with the time limits imposed by said requirements as applicant failed to submit all of the appropriate information to the office in a timely manner. At this point the effective filing date of the instant application is 3/6/2006 NOT 7/10/2001.

### *Specification*

5. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

(1) if a machine or apparatus, its organization and operation;

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- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. **The abstract of the disclosure is objected to because it contains numbers indicating references to figures.**

Correction is required. See MPEP § 608.01(b).

8. The title of the invention has been changed to reflect proper spelling of the word "investment".

### ***Claim Objections***

9. **Claim 5 is objected to because of the following informalities:** In the second limitation (Found on page 3 of the response received 9/19/2008), the term "holder" has been misspelled as "hold". Appropriate correction is required.

10. **Claims 2, 3 and 5 are objected to under 37 CFR 1.75(c)**, as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent

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form, or rewrite the claim(s) in independent form. The claims fail to introduce additional PHYSICAL limitations to the SYSTEM set forth in claim 1. That is, the claims fail to disclose any additional STRUCTURE, they merely add limitations as to the way applicant intends to use the system.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 13. Claims 1-3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims are vague, indefinite and incomplete as they recite a function or method of operation (e.g. invests, performs, investigates, determines, audits, judges, etc) with no structure to carry out said function.

Additionally, as set forth in MPEP 2173.05 (p)(II), a claim (such as claim 1) which recites both apparatus and method steps of using the apparatus, is indefinite. See Ex parte Lyell, 17 USPQ 2d 1548.

***Claim Rejections - 35 USC § 101***

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 15. Claims 1-3 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-3 and 5 embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only (note the discussion of this issue in section 12 above).

See MPEP 2173.05 (p)(II) and Ex parte Lyell 17 USPQ 2d 1548 at 1551.

- 16. Claims 1-3 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Claims 1-3 and 5** do not require the use of any specific technological arts or machine and can be performed by hand on within ones own mind.

Applicant's claims are directed towards a system, accordingly applicant should set forth the specific structures and apparatus that connote said system, not a manner of using a general purpose machine to perform some abstract manipulation of data without providing any useful, concrete, tangible result or transformation to a different state or thing.

Indeed, claim 1 recites that a trustee performs investment recovery management using a computer, however such a limitation is merely a "field of use" or an "insignificant

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extra solution activity” that does NOT actually REQUIRE a computer, as the process can be performed by hand with a pencil and paper or mentally.

Examiner’s Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



**19. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,253,191 B1 to Hoffman in view of U.S. Patent 5,214,579 to Wolfberg et al. (hereinafter Wolfberg).**

**Regarding claim 1,** Hoffman discloses applicants invention substantially as claimed, i.e. a system for managing project investment, characterized by comprising:

- a project holder that has a particular project (see figure 1, item 120 and associated text);
- an investor that invests in the particular project (see figure 1, item 105 and associated text); and
- a trustee (see figure 9B, item 955 and associated text) that is entrusted with components of the particular project by the project holder and performs investment recovery management using a computer.

Hoffman does not appear to expressly disclose that the investment recovery management is based on a dividend management program agreed upon in advance between the project holder and the investor.

Wolfberg discloses a system which manages monitors and reports growth of a participants base with respect to progress towards achieving a predetermined target amount selected by the participant in, for example, the Abstract, which reads on a dividend management program agreed upon in advance between the project holder and the investor.

At the time of the invention it would have been obvious to one of ordinary skill in the art to Combine the teachings of Wolfberg with the system in Hoffman and to modify

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Hoffman to include the teachings of Wolfberg regarding investment monitoring and estimation for the benefit of being able to track and estimate how long or when a predetermined target amount will be achieved, i.e. when will an investors investments reach a predetermined goal.

Hoffman and Wolfberg are related art because they both deal with investments.

Applicant is again reminded that claim 1 is directed towards a system, NOT a method of operating a system or even a method of managing project investment.

**It is noted that claim 1 contains statements of intended or desired use. However, there is well settled case laws that such statements (such as “that invests” “that is entrusted” “performs” agreed upon”, etc.) as to possible future acts or to what may happen in a method or operation, are essentially method limitations or statements of intended or desired use and do not serve to patentably distinguish the claimed structure over that of the references. See In Re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2<sup>nd</sup> 1647.**

See MPEP 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2<sup>nd</sup> 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

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Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2<sup>nd</sup> 1525, 1528

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

**Regarding claim 2** and the limitation wherein the trustee investigates the components of the project entrusted by the project holder and notifies the investor of a result of the investigation, and

the investor determines investment in the particular project based on the result of the investigation notified by the trustee, again see figure 9B, item 955 and associated text.

**Regarding claim 3** and the limitation further comprising an audit agency that audits progress of the project by the project holder, see figure 9B, item 960 and associated text.

**Regarding claim 5** and the limitations wherein:

when a payment request is sent from the project holder, the audit agency judges whether it is necessary to correct the payment request,

when it is judged that it is necessary to correct the payment request, the trustee instructs the project holder to correct the payment request, and, when it is judged that it is unnecessary to correct the payment request, the trustee executes payment to the project hold(er) (sic),

when payment is made to the trustee from the project holder, the audit agency judges whether a paid amount is appropriate in light of a state of progress of the project, and

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when it is judged by the audit agency that the paid amount is not appropriate, the trustee performs investment recovery management in accordance with a predetermined first dividend management correction program:

the audit agency judges whether it is possible to attain a target dividend amount in light of a state of progress of the project, and

when it is judged by the audit agency that it is impossible to attain the target dividend amount, the trustee extends a contract term of the investor and performs investment recovery management in accordance with a predetermined second dividend management correction program, see for example, Hoffman Figure 11 and associated text wherein it is understood that Hoffman is clearly capable of being used in the intended manner set forth by applicant.

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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